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09/747,927	12/27/2000	Toru Ueda	0033-0685P	3448
7590                    05/29/2008 BIRCH, STEWART, KOLASCH & BIRCH, LLP P.O. Box 747 Falls Church, VA 22040-0747			EXAMINER	
			VENT, JAMIE J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/747,927	<b>Applicant(s)</b> UEDA ET AL.
	<b>Examiner</b> JAMIE JO VENT	<b>Art Unit</b> 2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

1) Responsive to communication(s) filed on 28 February 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 16-22,24,26-28 and 30-38 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 16-22,24,26-28, 30-38 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed February 28, 2008 have been fully considered but they are not persuasive. On page 9-10 applicant argues that Yoshimura et al (US 5,596,419) in view of Takahashi et al (US 5,805,933) in further view of Ueki (US 6,310,848) fails to disclose, suggest, or teach the following limitation "an information recording portion recording information on a correspondence between the still image recorded by said still image recording portion and the video recorded by said video recording portion" as recited in Claim 1. Yoshimura et al discloses an information recording portion wherein the correspondence between the still image is recorded by the video recording portions as in Column 4 Lines 1-10 wherein information on the still image and video recorded images are recorded. Additionally, applicant argues on pages 9-10 applicant argues "a digital network interface digitally bi-directionally communicating with an external apparatus" as recited in Claim 1. It is taught by Takahashi teaches the use of bi-directionally communicating information as seen in Figure 1. The information is bi-directionally communicated via the network wherein digital information is shared among the various apparatuses as described in Column 5 Lines 26-67. It is further argued on page 10 that the slide show technique taught by Ueki would not realistically be combined as taught by the reference. The system as taught by the examiner merely relies on the technique of cutting still images after an allotted time (Column 27 Lines 35+) and then placing them in an order as taught by Ueki in order to provide an effective custom video recording order as claimed. The feature

being relied upon is not the slide show capabilities but the timing of cutting various still pictures from a moving image stream. On page 11 applicants further argues that the references fail to disclose "the cut out and records the still image by detecting a switching of a sound multiplex mode" as recited in Claim 26. It is well known in the art to use the switch of sound to determine the beginning of segments and thereby providing the cutting of images as taught by Ueki. Although, all of applicants points are understood the examiner can not agree and therefore the rejection is maintained.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 16-22, 24, 26-28, 30-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al (US 5,596,419) in view of Takahashi et al (US 5,805,933) in further view of Ueki (US 6,310,848).

**[claims 16 & 26]**

In regard to Claims 16 and 26, Yoshimura et al discloses a recording device comprising:

- a still image recording portion recording a still image (figure 1 shows a still video recording/reproducing device as further explained in Column 4 Lines 4-16);
- a video recording portion recording a video (figure 1 shows a vtr which is used for video recording as further described in Column 3 Lines 55+);

- an information recording portion recording information on a correspondence image recording portion between the still image recorded by said still and the video recorded by said video recording portion through a communication port (Column 4 Lines 5-33 describes the information from the image recording portion and the relation to the still image and as further seen in Figure 7);
- transmitting one or a plurality of the still image, said still image recording portion, said video recording portion and said information recording portion (Column 8 Lines 5+ describes the transmitting of still images in accordance with the video signal); however, fails to discloses
  - a digital network interface digitally bi-directionally communicating with an external apparatus.
  - A still frame producing portion producing a still image by cutting out the still image to be recorded in the still image recording portion from the video recorded by said video recording portion, wherein said still image producing portion cuts out a still image one of at a start of the video recording or after a prescribed time from the start of video recording and every time a prescribed period of time elapsed

Takahashi et al discloses an image processing system wherein various images are stored and reproduced. Furthermore, it is seen in Figure 10 a network interface 1501

that allows bi directional communication with the many components of the system. It is further seen that the input device controller receives and sends information via the data bus present in the system as described in Column 11 Lines 50+. The network interface allows for the user to input desired commands to be displayed or processed and thereby is connected to the system for further input. Additionally, Figure 10 also shows a communication port for other items to input data into the system as seen through items 1529 and 1531.

Yoshimura et al discloses the cutting of images as still image producing portion as described in Column 4 Lines 57+ describes the timing of still images in correlation to the video; however, fails to disclose the specific timing of the cutting of video. It is taught by Ueki to provide a system that cuts out still images after a prescribed time as described in Column 27 Lines 35+. It is described the control data to cut and display a still image for twenty seconds and after the prescribed time of twenty seconds switch to the next still image.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the video recording system which records still images and video signals, as disclosed by Yoshimura et al, and incorporate a system that has a digital network interface bi-directional communicating with the external apparatus, as disclosed by Takahashi, and further incorporate a system to provide a switching of still images after a prescribed time, as disclosed by Ueki, to allow for proper and efficient communication to the system as well as system that provides efficient command executing of images.

**[claim 17]**

In regard to Claim 17, Yoshimura et al discloses a recording device wherein said command executing portion transmits the still image and the information respectively recorded by said still image recording portion (Column 8 Lines 18+) however, fails to disclose that the recording portion is through said communicating portion giving a still image transfer command. Sakaegi et al discloses a system wherein the user via a remote control provides the system input on the processing and displaying of still images. As shown in Figure 5 is the method chart that the user is given in order to process and display the desired still image as seen in Figures 3a-3c. This process of selecting still pictures allows for the user to have control over the desired recording/reproducing functions of the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the video recording system which records still images and video signals, as disclosed by Yoshimura et al, and incorporate a system that has an external apparatus for communicating the processing of still image pictures, as disclosed by Sakaegi et al.

**[claim 18]**

In regard to Claim 18, Yoshimura et al discloses a recording device wherein said command executing portion transmits the still image recorded by said still image recording portion in accordance with a Direct Printing Protocol (Column 8 Lines 57+ through Column 9 Lines 1-18 describes the recording and transmitting the still images); however, fails to disclose the still image recording is in accordance with a Direct Printing Protocol. Sakaegi et al discloses a system, which incorporates a printer for printing of still images as seen in Figure 13 and described in Column 8 Lines 65+ through Column

9 Lines 1-8. It is further noted that a direct print protocol is needed to transfer data between a set top box and a printer due to the peer-to-peer transfer. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a recording device, as disclosed by Yoshimura et al, and incorporate a system with a printer, as disclosed by Sakaegi et al, which allows for the user to efficiently print still images that have been recorded.

**[claim 19]**

In regard to Claim 19, Yoshimura et al discloses a recording device wherein said command executing portion transmits the video data recorded by said video recording portion by an Audio Visual control (Figure 7 and 8 shows the transmitting of recording data by an audio visual control as further described in Column 7 Lines 50-61 and Column 8 Lines 19-44).

**[claim 20]**

In regard to Claim 20, Yoshimura et al discloses a recording device wherein said information on the correspondence between the still image and the video includes information representing a reproduction position of the video (Column 3 Lines 54-58 describes the still images being representative images of the video as well as positioning of the video).

**[claim 21]**

In regard to Claim 21, Yoshimura et al discloses a recording device wherein said information representing the reproduction position of the video designated by temporal

information (Column 4 Lines 5-18 describes the information representing the position of the video).

**[claim 22]**

In regard to Claim 22, Yoshimura et al discloses a recording device further comprising a searching portion searching and changing a reproduction starting point of the video based on information (Column 6 Lines 50+ describes the looking up of video from various points).

**[claim 24]**

In regard to Claim 24, Yoshimura et al discloses a recording device wherein said still image producing portion produces and records information on a correspondence between the still image and the video based on information dependent on the video (Column 3 Lines 54+ describes the still images that are dependent on the video signal).

**[claim 27]**

In regard to Claim 27, Yoshimura et al discloses a recording device wherein said still image recording portion, said video recording portion or said information recording portion records information on a recording medium which allows random access (Column 3 Lines 59+ describes the recording the signal onto the VTR which would allow for random access).

**[claim 28]**

In regard to Claim 28, Yoshimura et al discloses a reproducing device comprising:

- a still image display portion displaying a still image received (Figure 12 shows the still image display);

- a video display portion receiving a video corresponding to the still image displayed by said still image display portion through said communicating portion for display (Column 10 Lines 36+ describes the still images corresponding to the video signal which are displayed); however, fails to disclose a communicating portion communicating with an external apparatus.

Sakaegi et al discloses an image reproduction system wherein still images are reproduced in accordance to the video signal image as disclosed in Column 4 Lines 48+. Furthermore it is seen in Figure 1 a remote control 36 which is a communication port that allows for the user to input desired scenes or images to be displayed thereby giving more control of the recording/reproducing process to the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the video recording system which records still images and video signals, as disclosed by Yoshimura et al, and incorporate a system that has an external apparatus for communicating to the system, as disclosed by Sakaegi et al.

**[claim 30]**

In regard to Claim 30, Yoshimura et al discloses a reproducing device as described in Claim 16, with the additional limitations:

- a still image display portion displaying a still image received through said digital network (Figure 10 shows the display of still images from the network and further seen in Figure 12);

- an information receiving information on a correspondence between still image and a video through said digital network interface (Figure 1 shows information of video and still images being inputted into the system);
- a video display portion receiving the video corresponding to the still image displayed by said still image display portion through said network interface for display (Column 7 Lines 40\_ describes the receiving of still images to be displayed)
- an instruction issuing portion issuing an instruction for cutting out still image through said digital network interface (Column 4 Lines 57+ describes the timing of still images in correlation to the video); however fails to disclose a video selection command issuing portion transmitting information capable of selecting video through said digital network interface.

Takahashi discloses an image processing apparatus wherein the selection of video and still pictures are able to be selected as seen in Figure 10 and further described in Column 2 Lines 15-20 to provide the system the ability to select video data being processed by the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the still image system, as disclosed by Yoshimura et al and further incorporate a selection capability of selecting still pictures, as taught by Takahashi, to allow for a more efficient and user-friendly system of editing and selecting A/V data.

**[claim 31]**

In regard to Claim 31 the limitations has been previously discussed in Claim 18.

**[claim 32]**

In regard to Claim 32 the limitations has been previously discussed in Claim 20.

**[claim 33]**

In regard to Claim 33 the limitations has been previously discussed in Claim 21.

**[claim 34]**

In regard to Claim 34, Yoshimura et al discloses a reproducing device wherein said command issuing portion transmits said information on the correspondence between the still image data and the video with a video transfer command when said command issuing portion issues said video transfer command through said communicating portion, and said video display portion receives video communicating portion for display (Column 3 Lines 54+ describes the transmitting of still images that are dependent on the video).

**[claim 35]**

In regard to Claim 35 the limitations has been previously discussed in Claim 19.

**[claim 36]**

In regard to Claim 36 the limitations has been previously discussed in Claim 28.

**[claim 37]**

In regard to Claim 37, Yoshimura et al discloses a reproducing device wherein said command issuing portion issues a command of requesting transmission of videos corresponding to the still image through said communicating portion in an order of the still images displayed onto said still image display portion (Figure 12 shows the still

images that are displayed and processed and it is further described in Column 10 Lines 35+ the command issuing portion that requests the transmission of the still pictures).

**[claim 38]**

In regard to Claim 38, Yoshimura et al discloses a reproducing device further comprising a switching portion switching positions of the still images displayed on said still image display portion (Column 10 Lines 35+ describes the switching positions of the still images).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMIE JO VENT whose telephone number is (571)272-7384. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jamie Vent  
/ROBERT CHEVALIER/  
Primary Examiner, Art Unit 2621  
May 27, 2008.